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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,520	09/28/2006	Jean-Marc Suau	296739US0PCT	1815

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BARKER, MICHAEL P

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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11/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/594,520	Applicant(s) SUAU ET AL.	
	Examiner MICHAEL BARKER	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 16-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-26 are pending in this Application.

Information Disclosure Statement

The information disclosure statement filed 12/18/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

Specifically, no English translation is given of Reference "AR" at p. 1 of the IDS. As such, the reference has not been considered, and any resulting patent from this Application will not get the presumption of validity over this reference. Each reference aside from AR was properly submitted and considered.

Response to Restriction

In the reply filed 09/10/2009, Applicant elected Group II and species sodium 2,2'-[carbonothioylbis(thio)]bispropanoic acid with traverse. The traversal is based on US law and does articulate any rationale as to why unity of invention is not lacking. Per unity of invention, Applicant simply states,

37 C.F.R. § 1.475(b) provides in relevant part that a "national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to (3) a product, process especially adapted for the manufacture of said product, and the use thereof.

Such a statement is not considered to particularly point out why the Restriction Requirement was improper. For instance, Applicant makes no argument that the Examiner erred in breaking unity of invention with the compound having registry number 6332-91-8. Accordingly, Applicant's election to the Restriction Requirement is treated as having been made without traverse.

As such, Groups I and III, drawn to claims 1-8 and claims 16-26 respectively are withdrawn as being drawn to non-elected subject matter. Applicant elected the process of manufacturing the compounds of formula (I). Accordingly, rejoinder practice does not apply, and the withdrawn claims will not be rejoined.

While no prior art has been found regarding the process described in claims 9-15, in the Specification, at p. 11, Applicant states,

The Applicant stresses that the document DD 217 214 reveals trithiocarbonate compounds of the type $S=C(SR)_2$, where R can be an alkyl grouping, which may possibly be carboxylated. However, this document in no way reveals the existence of particular compounds of formula (I) according to the invention.

As noted in the Information Disclosure Statement subsection above, DD 217214 has not been considered, since an English translation has not been provided. Furthermore, the Examiner is unable to locate an English translation and requests Applicant provide one.

Rejections

Obviousness-Type Double Patenting: The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not

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patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent Application No.

10/594,519. Although the conflicting claims are not identical, they are not patentably distinct from each other. The compounds recited in claims 1-14 of the '519 Application overlap in scope with the products resulting from the process of preparing compounds of formula (I) recited in claims 9-15.

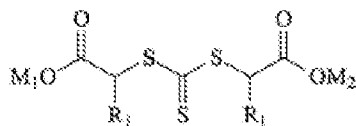
35 USC 112, second paragraph: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 10 are rejected under 35 USC 112, second paragraph for the following ambiguities:

(1) Claim 9 recites, "Process for manufacturing in water a compound of formula (I) comprising the steps of: . . ." However, while formula (I) is clearly defined in

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claim 1, as,



where R_1 designates an alkyl radical having 2 to 10 carbon atoms, an aromatic radical possibly optionally substituted by an alkyl chain having 1 to 4 carbon atoms; and where M_1 and M_2 designate the hydrogen atom, an amine salt, ammonium or an alkaline cation, and are identical or different.

claim 9 goes on to define the substituents R_1 , M_1 , and M_2 different than those of claim 1.

It is unclear whether Applicant intends the substituents of formula (I) to be defined as in claim 1 or as in claim 9. Furthermore, as claim 9 is an independent claim and must stand alone, the structure of formula (I) should be included in the claim language.

(2) Claim 9 recites, "where M designates ammonium or an alkaline cation".

However, within the Specification, an alkaline cation is repeatedly exemplified by sodium, lithium, and potassium, each of which are commonly referred to as alkali metals and would presumably be referred to as alkali cations. It is unclear from claim 9 whether Applicant intends to include alkaline cations, which would, presumably, refer to alkaline earth metals, i.e., Group II metals – Be, Mg, Ca, Sr, Ba, and Ra.

Claim 10 recites an improper Markush group, "wherein the alkaline cations are chosen from among sodium, potassium and lithium." It is unclear whether Applicant intends this group to be open or closed. As written, the words "from among" would indicate the group is open. However, recitation of three exact cations indicates the group is most likely closed. Clarification is requested.

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Conclusion

Any questions about this Office Action may be directed toward Examiner Michael Barker at 571.272.0303. If, however, attempts to reach Mr. Barker are not successful, the Examiner's supervisor, Joseph McKane, may be reached at 571.272.0699.

/MICHAEL BARKER/

Examiner, Art Unit 1626

/Kamal A Saeed/

Primary Examiner, Art Unit 1626